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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/322,289 05/28/99 SCHENK

D 15270-004740

EXAMINER

020350 HM12/0929
TOWNSEND AND TOWNSEND AND CREW LLP
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ART UNIT NUMBER, S PAPER NUMBER

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DATE MAILED

09/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/322,289

Applicant(s)

Schenk

Examiner

Sharon L. Turner, Ph.D.

Group Art Unit

1647



☒ Responsive to communication(s) filed on 4-6-00

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-55 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-55 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

☒ Notice to Comply with Sequence Rules

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-32, and 35-37, drawn to a method of preventing or treating by administration of an antibody, classified in class 424, subclass 130.1.
 - II. Claims 33-34, drawn to a method of preventing or treating by administration of a polynucleotide, classified in class 514, subclass 44.
 - III. Claims 38-52, drawn to a method of preventing or treating by administration of a polypeptide, classified in class 424, subclass 184.1.
 - IV. Claim 53, drawn to a composition of peptide and adjuvant, classified in class 530, subclass 300.
 - V. Claims 54-55, drawn to a method of screening to the extent of administering an antibody, classified in class 424, subclass 132.1.
 - VI. Claims 54-55, drawn to a method of screening to the extent of administering an active fragment of A β , classified in class 424, subclass 185.1.
2. The inventions are distinct, each from the other because of the following reasons:
3. Groups I-III, V and VI are related as processes. The processes are distinct each from the other in reagents, steps and outcomes or functions. For example the methods of groups I and V comprise administering antibodies whereas the method of groups II and VI administer polypeptides and the method of group III administers nucleic acids which each differ in structural

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components, (i.e., nucleic acids, amino acids and heavy and light chains). The methods of groups I-III treat or prevent disease whereas the methods of groups V and VI screen compounds for use in treatment of Alzheimer's.

4. Inventions IV and I-III, V, VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the processes claimed may be practiced with the alternative plaque component tau and the composition may be used to activate T and B cells.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and the search required for each of the groups is not required for any other group, restriction for examination purposes as indicated is proper.

7. This application contains claims directed to the following patentably distinct species of the claimed invention: Invention I species; A) antibodies to AB peptide, B) antibodies to AB 1-28 peptide, C) antibodies to AB 1-10 peptide, D) antibodies to AB 1-16 peptide, E) antibodies to AB 1-5 peptide. Invention III species; A) AB 1-12 peptide, B) AB 1-16 peptide, C) AB 13-28

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peptide, D) AB fragment free of at least the 5 C-terminal amino acids in AB43, E) AB fragment comprising 20 contiguous amino acids.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-2, 4-8, 32, and 35-38 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to, Sharon L. Turner, Ph.D. whose telephone number is (703) 308-0056. The examiner can normally be reached on Monday-Thursday from 7:30-6:00 P.M.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (703) 308-4623.

Sharon L. Turner, Ph.D.
September 25, 2000

Patricia A. Duffy
PATRICIA A. DUFFY
PRIMARY EXAMINER



UNITED STATES DEPARTMENT OF COMMERCE
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EXAMINER	
ART UNIT	PAPER NUMBER

Please find below a communication from the EXAMINER in charge of this application

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. § 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. §§ 1.821-1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

APPLICANT IS GIVEN 30 days FROM THE DATE OF THIS LETTER WITHIN WHICH TO COMPLY WITH THE SEQUENCE RULES, 37 C.F.R. §§ 1.821-1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 C.F.R. § 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 C.F.R. § 1.136. In no case may an applicant extend the period for response beyond the six month statutory period. Direct the response to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the response.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Turner whose telephone number is (703) 308-0056. If the examiner cannot be reached, inquiries can be directed to Supervisory Patent Examiner Gary Kunz whose telephone number is (703) 308-4623. The fax number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Patricia A. Duffy
PATRICIA A. DUFFY
PRIMARY EXAMINER